

REMARKS

Counsel thanks Examiner M. Hand for the courtesy of an interview held on November 6, 2006. Numerous arguments were offered by Applicants' representative at the interview in support of Applicants' position that a prima facie case of obviousness has not been properly established. These and other arguments are officially submitted herein for the Examiner's consideration.

No amendments have been made in response to the Office Action.

The 35 U.S.C. 103(a) rejection of claims 1-20 as being obvious over *Olson* (U.S. Patent No. 6,297,424) is traversed, because a prima facie case of obviousness has not been properly established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, **there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art**, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See MPEP, section 2143 quoting *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The rule is obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either **in the references themselves or in the knowledge generally available to one of ordinary skill in the art**. See MPEP 2143.01 quoting *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (emphasis added); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicants respectfully submit that the rejection has not met at least the first criterion.

As to independent claim 1, the Examiner alleged, in the Office Action, at page 3, lines 1-5 from bottom, that it would have been obvious to a person of ordinary skill in the art to attach the *Olson* strands in the claimed manner, because "such an attachment would provide more freedom of movement of the chassis in the stomach region and therefore more freedom of movement in that region for the user." However, the Examiner has not specified whether her suggestion or motivation to modify *Olson* could be found (i) in the reference itself or (ii) in the knowledge generally available in the art. If the former, i.e., (i), the Examiner is kindly asked to cite column and line numbers where *Olson* provides the Examiner's suggestion or motivation. If the latter, i.e., (ii), the Examiner is kindly asked to cite a reference or references of good date that show(s) that it was

known in the art at the time the claimed invention was made to provide the claim feature to obtain the advantages alleged by the Examiner in the Office Action, at page 3, lines 1-2 from bottom.

As discussed in the previous Amendment, the cited passage at column 11, line 13 through column 12, line 6 of *Olson* only discloses conventional waist or leg hole elastics, and is completely silent on whether such elastics might have middle portions that are free of direct securement to the chassis in the presently claimed manner. The remaining parts of *Olson* also fail to teach or suggest the claims limitation.

Accordingly, Applicants respectfully submit that claim 1 is patentable over *Olson*, and request that the obviousness rejection of claim 1, as well as claims 2-4 and 6-20 depending therefrom, be withdrawn.

As to independent claim 5, Applicant respectfully traverses the Examiner's rejection because *Olson* fails to teach or suggest the limitation of claim 5 that a length of said auxiliary elastic members in the waist-surrounding direction as measured in a contracted state thereof is generally equal to a corresponding length of the absorbent structure in the one of said front and rear waist regions. The Examiner's argument regarding claim 5 in page 4 of the Office Action is noted. However, the Examiner appears to argue that the length of *Olson* elastics in a contracted state thereof is generally equal to a corresponding length of the front and rear waist regions, which is not claimed. Applicant claims a corresponding length of the absorbent structure, which is neither mentioned in the Examiner's argument nor disclosed/suggested by the applied reference.

It should be noted that the invention of claim 5 provides the advantage disclosed in page 16, lines 6-11 of the specification, i.e., the absorbent structure is wrinkle-free in the middle region corresponding to the middle regions of the auxiliary elastic members. This advantage is not deemed disclosed or suggested by the applied reference.

Accordingly, Applicant respectfully submits that claim 5 is patentable over *Olson*, and request that the obviousness rejection of claim 5 be withdrawn.

Claims 2-4 and 6-20 depend from claim 1, and are considered patentable at least for the reason advanced with respect to amended claim 1. The dependent claims are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught

nor suggested by the applied art.

For example, the invention of claims 6 and 18 provides the advantage disclosed in page 15 of the specification, especially at lines 1-5 and lines 20-23, i.e., the middle region of the outer sheet is substantially free of gathers and the picture in that middle region is not distorted and remains easily recognizable.

As to claims 11-12, note the discussion *supra* with respect to claim 5.

As to claim 13, *Olson* does not fairly teach or suggest the claim limitation that an entire section of said middle portion which is located between the transversely opposite side edges of said absorbent structure is directly bonded neither to the inner sheet nor to the outer sheet. The Examiner's argument regarding claim 13 found in page 5 of the Office Action is noted. Basically, the Examiner argued that since "the elastic strands can be bonded to the outer cover in such a manner as to remain free of direct securement to the chassis," such a manner of bonding would also result in the claimed structure of claim 13. Applicants respectfully disagree.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See *MPEP*, section 2143.01.III (emphasis added).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). *MPEP*, section 2142 (emphasis added).

In this particular case, the Examiner merely argued that the reference can be modified in the claimed manner, without presenting a convincing line of reasoning as to why a person of ordinary skill in the art would have made the suggested modification. Thus, the rejection of claim 13 is improper and should be withdrawn.

As to claims 14-16, the cited portion of *Olson*, i.e., column 14 lines 32-35, does not teach or suggest that the bonding sites are distributed between every pair of adjacent auxiliary elastic members. See, e.g., claim 14.

As to claim 17, *Olson* does not fairly teach or suggest the claim limitation that each of said auxiliary elastic members is entirely free of direct attachment to said chassis except at the opposite end portions of said auxiliary elastic member. Note, again, the discussion *supra* with respect to claim 1.

As to claims 18 and 20, *Olson* does not fairly teach or suggest the claimed gather-free feature.

As to claim 19, *Olson* does not fairly teach or suggest that the auxiliary elastic members are disposed between said elasticized waist hole and said elasticized leg holes. *Olson* discloses only waist and leg hole elastics, and fail to teach or suggest any auxiliary elastic members located between such waist and leg hole elastics. The Examiner's argument regarding claim 19 in page 7 of the Office Action is noted. Applicants respectfully direct the Examiner's attention to column 13 lines 23-26 and 53-56 where *Olson* discloses that elements 80, 82, 84 are all simulated elastic bands. The reference clearly fails to teach or suggest the claimed auxiliary elastic members.

Each of the Examiner's rejections has been traversed. Accordingly, Applicant respectfully submits that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

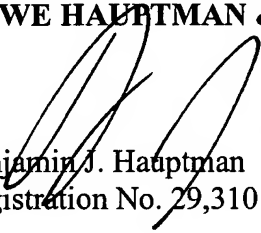
The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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